



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,197	01/02/2001	Klaus W. Berndt	P-5222	2915

26253 7590 03/12/2003  
BECTON, DICKINSON AND COMPANY  
1 BECTON DRIVE  
FRANKLIN LAKES, NJ 07417-1880

EXAMINER

TREMBLAY, MARK STEPHEN

ART UNIT PAPER NUMBER

2827

DATE MAILED: 03/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/753,197

Applicant(s)

BERNDT, KLAUS W.

Examiner

Mark Tremblay

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_.

Applicant: Berndt

Filing date: 1/2/2001

***Double Patenting***

5 The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 10 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

15 Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

20 Claims 1-9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of copending Application No. 09/752,984. Although the conflicting claims are not identical, they are not patentably distinct from each other because a transparent window is suitable for transmission measurements. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use a transparent window for transmission measurements because a transparent window transmits light that can be measured.

25 This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5

Claims 1-4 are rejected under 35 U.S.C. § 102(b) as being anticipated by Japan KOKAI 11-352,411 to Berndt (" '411" hereinafter). '411, [published 12/24/1999, and which is the Japanese translation of US Application #09/085,689, which Examiner uses as a faithful and definitive translation of '411], discloses:

10 an apparatus for hematologic evaluation of individual blood cells arranged in a monolayer which avoids morphology changes in a liquid, the apparatus comprising:

(a) a container (see figures) for suspending particles in a liquid, said container having at least one transparent window (1,2);

15 (b) a means for illuminating the suspension with a wavelength of light (inherent in the disclosure of "microscopic analysis" which requires illumination with at least a wavelength of light, and in the disclosure of "spectroscopic investigations"),

(c) a means for measuring the intensity of light that reemerges from said suspension (inherent in the disclosure of "microscopic analysis" which requires illumination with at least a wavelength of light, and in the disclosure of "spectroscopic investigations"); and

20 (d) a means for changing the thickness of said container by a known amount (see figure 3, wherein the thickness of the container has been changed a known amount, as determined by laser deflection; since the curvature of the deflection has been measured by laser deflection for one sample and one container, the change in the thickness will be known within a very close range in all future deflections).

25

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U. S. Patent #5,427,959, U. S. Patent #6,235,536, U. S. Patent #4,790,640, U. S. Patent #5,948,686, WO 9945365 A1, and WO 9945385 A1 are cited for showing a cuvette which uses  
30 variable thicknesses for volumetric analysis of blood.

U. S. Patent #5,715,082 is cited for showing a plunger fixed to a microscope for marking slides.

***Allowable Subject Matter***

Claims 6-9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The prior art fails to teach or suggest the plunger fixed with respect to the microscope which comes into contact with the container to change the thickness of the container by a known amount, in the context of the remainder of the claim recitations. Plungers, however, are also known as mechanical elements for the translation of the stage or the microscope objective. What is obvious from '411 is to change the thickness of the container before bringing it close to the objective of the microscope, i.e. to deform it before putting it in the microscope, since the cover stays in place once it is deformed. A plunger might be used to do this. In fact, it would be difficult to envision deforming the cover plate of '411 without a plunger (i.e. by using an air or water jet?) as broadly recited. The invention of fixing the plunger to the microscope to change the thickness of the container is simply not suggested by the '411 disclosure, and this arrangement represents a non-obvious improvement in the useful arts.

***Voice***

Inquiries for the Examiner should be directed to Mark Tremblay at (703) 305-5176. The Examiner's regular office hours are 10:30 am to 7:00 pm EST Monday to Friday. Voice mail is available. If Applicant has trouble contacting the Examiner, the Supervisory Patent Examiner, Michael Lee, can be reached on (703) 305-3503. Technical questions and comments concerning PTO procedures may be directed to the Patent Assistance Center hotline at 1-800-786-9199 or (703) 308-4357.

**MARK TREMBLAY  
PRIMARY EXAMINER**

March 9, 2003